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Attorney Docket No.: 58764.000036

Gp/1638

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Greta ARNAUT, et al.

Group Art Unit: 1638

Application Number: 10/040,906

Examiner: Anne R. KUBELIK

Filed: January 9, 2002

For: NOVEL BACILLUS THURINGIENSIS INSECTICIDAL PROTEINS

TRANSMITTAL LETTER

Mail Stop Patent Application

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

The following are enclosed for consideration in the above-identified application:

	FEE
<input type="checkbox"/> Response to Notice to File Missing Parts	\$
<input checked="" type="checkbox"/> Response to Office Action Restriction Requirement of September 12, 2003	\$
<input type="checkbox"/> Declaration: <input type="checkbox"/> Original; <input type="checkbox"/> Supplemental	\$
<input type="checkbox"/> Submission of Formal Drawings	\$
<input type="checkbox"/> Informal Drawings: ___ Sheets ___ Figures	\$
<input type="checkbox"/> Information Disclosure Statement, Form PTO SB/08A, and (4) four references	\$
<input type="checkbox"/> Amendment: <input type="checkbox"/> Preliminary; <input type="checkbox"/> § 116; <input type="checkbox"/> § 312; <input type="checkbox"/> Other	\$
<input checked="" type="checkbox"/> Petition for One-Month Extension of Time	\$110.00
<input type="checkbox"/> Issue Fee: <input type="checkbox"/> Part B - Issue Fee Transmittal <input type="checkbox"/> Part C - Charge to Deposit Account	\$
<input type="checkbox"/> Notice of Appeal	\$
<input type="checkbox"/> Appeal Brief	\$
<input type="checkbox"/> Request for Oral Hearing	\$
<input type="checkbox"/> Reply Brief	\$
<input type="checkbox"/> Terminal Disclaimer	\$
<input type="checkbox"/> An additional claim fee is required, and is calculated as shown below	\$
TOTAL FEES BEING SUBMITTED	\$110.00

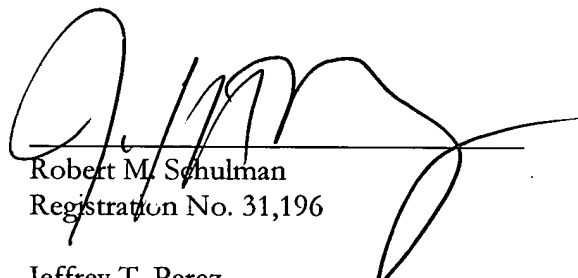
	Claims Remaining	Claims Paid For	Extra	Rate	Fee
Total Claims			0	x \$18.00	\$
Independent Claims			0	x \$86.00	\$
Multiple Dependent Claims (if applicable)				\$	\$
TOTAL EXCESS CLAIMS FEE					\$
SMALL ENTITY TOTAL (if applicable)					\$.00

The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and § 1.17 associated with this communication or credit any overpayment to the deposit account of Hunton & Williams, Deposit Account Number 50-0206.

Respectfully submitted,

Dated: November 12, 2003

By:


 Robert M. Schulman
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In re Application of:

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For: NOVEL BACILLUS THURINGIENSIS INSECTICIDAL PROTEINS

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) Group Art Unit: 1638
)
) Examiner: Anne R. KUBELIK
)
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)

Response To Office Action Restriction Requirement and One Month Extension of Time

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Extension of Time

In response to the Office Action mailed September 12, 2003, please find a check for \$110.00 to extend the period for reply to and including November 12, 2003. In the event of any variance, the Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16 and 1.17, which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-0206.

Response

Responsive to the Office Action mailed September 12, 2003, please consider the following:

Response to the Restriction Requirement begins on page 2 of this paper.

11/14/2003 JBALINAN 00000021 10040906
01 FC:1251 110.00 DP

RESTRICTION REQUIREMENT

In the Office Action of September 12, 2003 and previous March 7, 2003 Restriction Requirement, the Examiner requested restriction to one of the following inventions under 35 U.S.C. § 1.121.

- I. Claims 1-12 and 22-56, drawn to a nucleic acid encoding an insecticidal protein, a chimeric gene comprising the nucleic acid, plants, plant cells and seeds comprising the chimeric gene and a method of using it to make plants resistant to insects; and
- II. Claims 13-21, drawn to an insecticidal protein.

As stated in Applicants' response filed on July 7, 2003, Applicants hereby elect Group I, claims 1-12 and 22-56 (now represented by claims 57-78) drawn to a nucleic acid encoding an insecticidal protein, a chimeric gene comprising the nucleic acid, plants, plant cells, and seeds comprising the chimeric gene and a method of using it to make plants resistant to insects.

As previously stated Applicants elect Group I without traverse, however, the Examiner also required election of a single nucleotide or amino acid sequence as they "normally constitute independent and distinct inventions." In the previous response Applicants failed to elect a specific sequence, therefore Applicants now elect SEQ ID NO:2 with traverse.

Applicants believe there would be no undue burden on the Examiner to search each variation found in Group I as each sequence is related to SEQ ID NO: 2 (SEQ ID NO:8 has one insertion and SEQ ID NOS: 7 and 9 are the nucleotide sequences corresponding to SEQ ID NO:8). More particularly, the USPTO purports that it would be burdensome to search the amino acid sequence as defined by SEQ ID NO:2 and the amino acid sequence defined by SEQ ID NO:8 although there is only a single amino acid difference between the two. SEQ ID NO:8 comprises an insertion of Ala following the first Met, which is in position 1 of both sequences. Additionally, SEQ ID NOS: 7 and 9 correspond to the DNA sequences for the same protein with one being from cotton and the other being from corn and would not be burdensome to search as they are within the scope of the protein of SEQ ID NO:8.

For the reasons stated above Applicants maintain it would not be burdensome on the USPTO to examine the claims represented by Group I, particularly Applicants maintain it would not be burdensome to search SEQ ID NOS: 2 and 8.

Conclusion

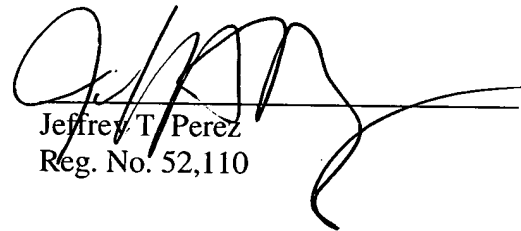
Entry of the foregoing and prompt and favorable consideration of the subject application on the merits are respectfully requested. In the event there are any outstanding issues the Examiner is welcome to contact the undersigned.

Respectfully submitted,

HUNTON & WILLIAMS LLP

November 12, 2003

By:


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